

REMARKS

Reconsideration of this application is respectfully requested.

In response to the rejection of claims 1-31 under 35 U.S.C. §112, a typographical error has been corrected in claim 1 thus obviating this ground of objection/rejection.

The drawing objections made on Form PTO-948 have been noted and will be obviated in response to a Notice of Allowance. In this regard, the Examiner's attention is also drawn to the attached separate letter to the Chief Draftsperson requesting approval of several minor drawing amendments as shown in red ink on the attached sheets of drawings. Subject to the Examiner's approval and a Notice of Allowance, a suitably amended substitute set of formal drawings will be filed incorporating these proposed amendments as well as obviating the other outstanding formal objections.

The abstract, specification and claims have also been amended above so as to place them in more traditional US format.

Accordingly, all outstanding formal issues are now believed to have been resolved in the applicant's favor.

The rejection of claims 1-31 under 35 U.S.C. §103 as allegedly being made "obvious" in view of the single cited Sato et al '968 reference is respectfully traversed.

Since the Examiner elsewhere has indicated claims 12-15, 30 and 31 to contain allowable subject matter, it is presumed that the Examiner intended to only reject claims 1-11 and 16-29 (and, indeed, these are the only claims about which there is any specific allegation of "obviousness"). Accordingly, claims 12-15, 30 and 31 have been amended above to self-standing allowed form and no further comment will be made with respect to these now presumably allowed claims.

The applicant has described and claimed a portable computer -- which, in its own right, includes its own data processor having a multiplicity of stored possible modes of operation and which is responsive to the output of a computer movement detector to provide a selected mode response from among the multiplicity of possible modes of operation. Dependent claims 2-31 add many more novel and patentable features as will be discussed in more detail below.

By contrast, the single applied Sato '968 reference is directed only to a portable pen-shaped input apparatus -- which is intended for connection at the input port of a data processing device such as a computer. However, there is no description in Sato '968 of the computer itself -- and certainly no suggestion at all that the mode of operation of the connected computer or of the input apparatus itself could be selectively changed by detected motion of the input apparatus.

In any event, claim 1 is directed to a portable computer wherein its processing means has a mode of operation selected from a multiplicity of stored possible modes by the output of an internal movement detection means responding to movement of the portable computer itself. With respect to such subject matter, Sato '968 is basically irrelevant.

Indeed, the Examiner's own comments describes Sato et al not as a "computer" but rather, as a "portable pen-shaped input". Furthermore, the Examiner admits a major deficiency of the Sato et al teaching:

"...Sato et al do not teach a processing means to provide a mode response selected from a multiplicity of stored possible modes but it would have been obvious to one of ordinary skilled [sic] in the art to this particular element to Sato et al because it would be very suitable for inputting Figures and characters, etc. into a data processing." [page 3 of the outstanding Office Action, first paragraph].

To merely restate the Examiner's attempt to find a motivation or suggestion for the applicant's invention in the Sato et al teaching is to immediately recognize that there is no such motivation or suggestion actually present in Sato et al. The Examiner's hindsight recognition that it might be "very suitable" is not germane -- even arguendo -- because this observation is made after having knowledge of the applicant's invention. It also is a far cry from any suggestion or motivation contained in Sato '968 itself. Indeed, the portable pen-shaped input apparatus of Sato '968 appears to have only one single mode of operation -- the processing of detected pen movements in a handwriting detection process so as to generate input signals to a computer representing handwritten information.

Accordingly, it really does not make any sense to consider even the possibility of changing the mode of operation of the pen-like input device as a result of its detected movements.

With respect to claim 8, the Examiner alleges Sato et al to include a display screen. However, the undersigned cannot find any display screen depicted at any of the drawings or described in any of the text of Sato et al. Indeed, the Sato '968 pen-shaped handwriting input apparatus does not have a display screen of any kind.

Accordingly, contrary to the Examiner's allegations with respect to claim 8, there can be no conceivable suggestion in Sato et al for the portable computer recited in claim 8 wherein the computer is required to have a display means and the processing means is required to include a screen output mode in which detected movement data is used to modify its output to the display means of the computer.

With respect to claims 9-11, the Examiner alleges that it would have been "obvious" to effect scrolling of displayed information based on detected movement data. However, with respect, although Sato '968 does purport to teach a movable pen-shaped handwriting input apparatus capable of detecting handwritten information based on movements of the pen-shaped apparatus, it does not have any display and there is no teaching or suggestion whatsoever that any display (whether on the pen-shaped input apparatus itself on a connected computer) should be caused to scroll as a result of relative

tilting or rolling movements. Indeed, the Sato '968 teaching shows that the input device has only one mode of operation -- that of detecting handwriting movements and outputting the results to a computer of some sort. However, there is no indication whatsoever that the Sato '968 device could or should be used to control scrolling movements of displayed information.

Once again, instead of finding any support whatsoever for this allegation of "obviousness" in the actual teachings of Sato et al '968, the Examiner refers back to the "same reasons given in claim 1" -- which, as noted above, rest on nothing more than a naked unsupported allegation of the Examiner. In reality, there is no motivation or suggestion to make the modifications now suggested by the Examiner with undue hindsight.

With respect to claims 16-22, the Examiner:

"...takes the official notice that a portable device having a user's password, a sound input device, speech or other sound signals, a sound output in combination with a radio transceiver whereby cellular or radio telephony networks, radio transmission or infrared transmission means, transmission of coded signals including a message for display is well known in the art."

However, the Examiner is reminded that the applicant is not claiming to be the first to ever invent such individual features per se. In the context of the claim considered "as a whole" (as it must be under the explicit language of 35 U.S.C. §103), and in accordance with standard MPEP practice, the Examiner is respectfully requested to support these allegations of "official notice" by citation of specific prior art references

actually teaching these particular features. Of course, such prior art teachings, if they exist, should be cited with respect to the overall context of the claimed invention "taken as a whole" as required under 35 U.S.C. §103.

With respect to claims 23-29, the Examiner once again states:

"...It is also well known to have a processing means responsive to received encoded radio signals to activate a paging alert which comprises a tone, a operation of a vibrating means and that the portable computer houses in a casing shape to facilitate a user holding the computer as a writing stylus."

Once again, the applicant is not claiming to be the first person to invent a wireless paging device. However, the undersigned is not familiar with any prior wireless paging device provided in a shaped housing that facilitates the user holding the paging device as a writing stylus. Furthermore, even with respect to the wireless paging features of these claims, as noted above, 35 U.S.C. §103 requires that these features be considered in the claimed context "as a whole" -- not as isolated features per se. As before, in accordance with standard MPEP practice, the Examiner is respectfully requested to support these allegations with specifically cited prior art references teaching the alleged features that the Examiner now maintains to be "well known". Of course, such features should be demonstrated by the Examiner with specific prior art citations to be "well known" in the context of the claimed invention taken as a whole -- because that is what is required under the standards of 35 U.S.C. §103.

The Examiner's attention is also drawn to new claims 32-76. Of this group, independent claim 32 claims a portable computer comprising, inter alia, a visible display screen, etc. Dependent claims 33-62 are comparable to dependent claims 2-31 in many respects.

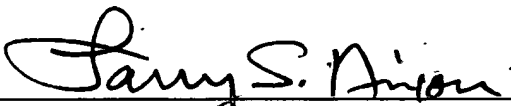
New method claims 63-76 are also presented in an effort to provide the applicant with an appropriate scope of protection for this novel and non-obvious invention. It will be noted, for example, that independent method claim 63 is directed towards a method of operating a portable handheld computer having an internal data processor capable of operating in plural different modes and controlling a visible display carried on the portable computer. The method requires generating a mode control signal corresponding to physical movement of the computer and then selectively changing the operating mode of the processor in response to the mode control signal. Dependent claims 64-76 add further significant patentable distinctions over the cited prior art.

Accordingly, this entire application is now believed to be in allowable condition and a formal Notice to that effect is respectfully solicited.

WILLIAMS
Serial No. 09/171,921

Respectfully submitted,

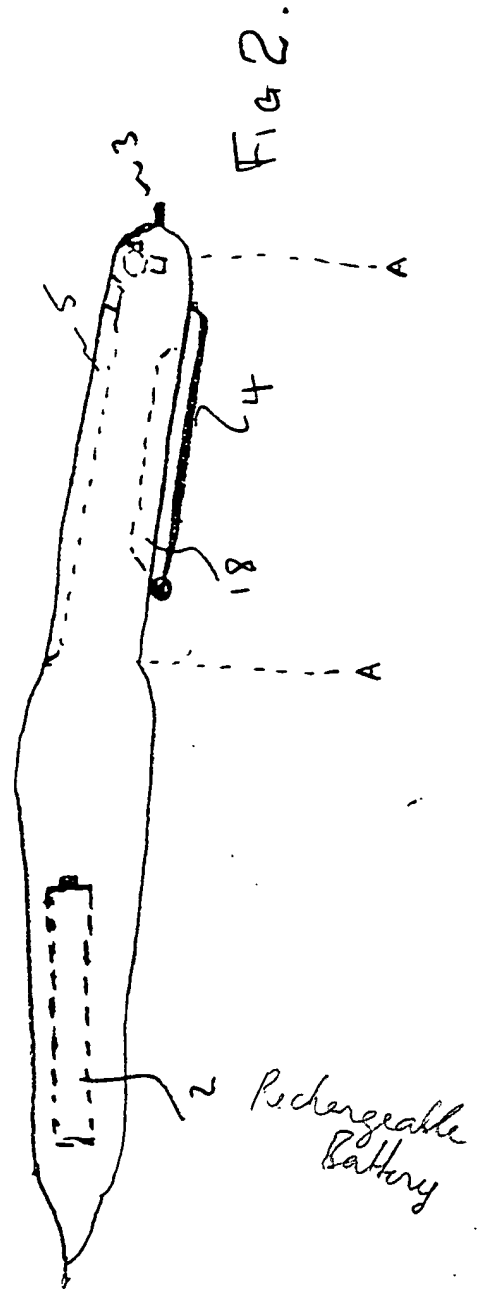
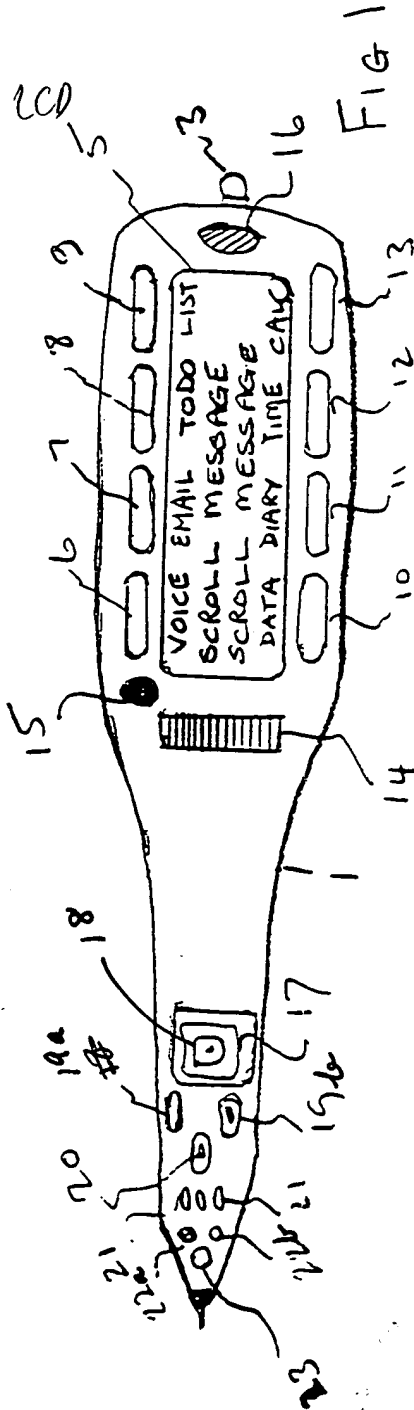
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Approved
by R2
1/12/07

PROPOSED DRAWING AMENDMENTS
FOR SN 09/171,921



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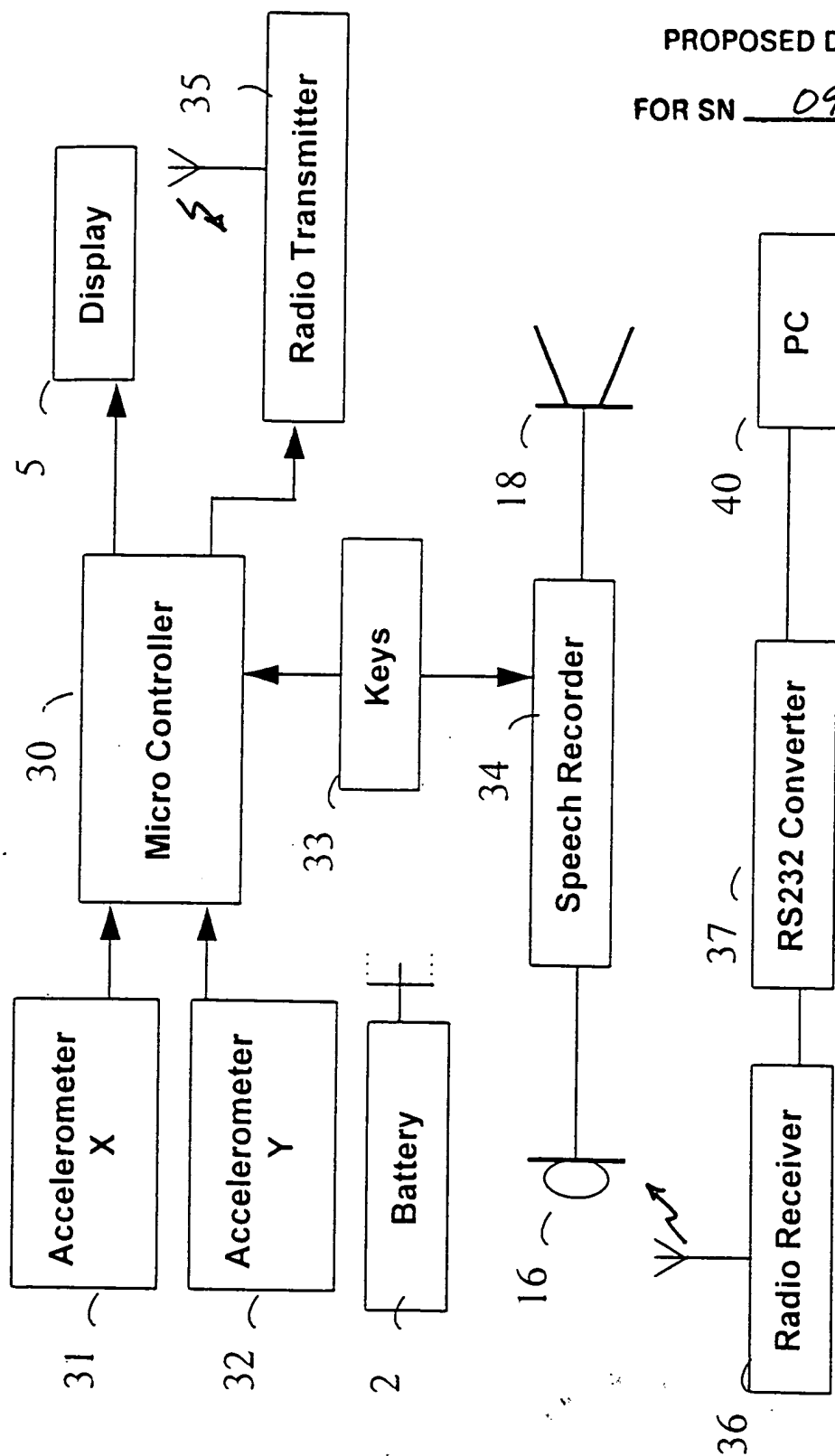


Fig 3

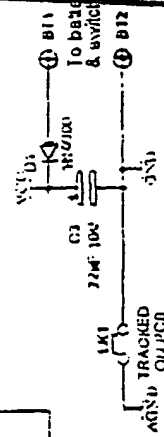
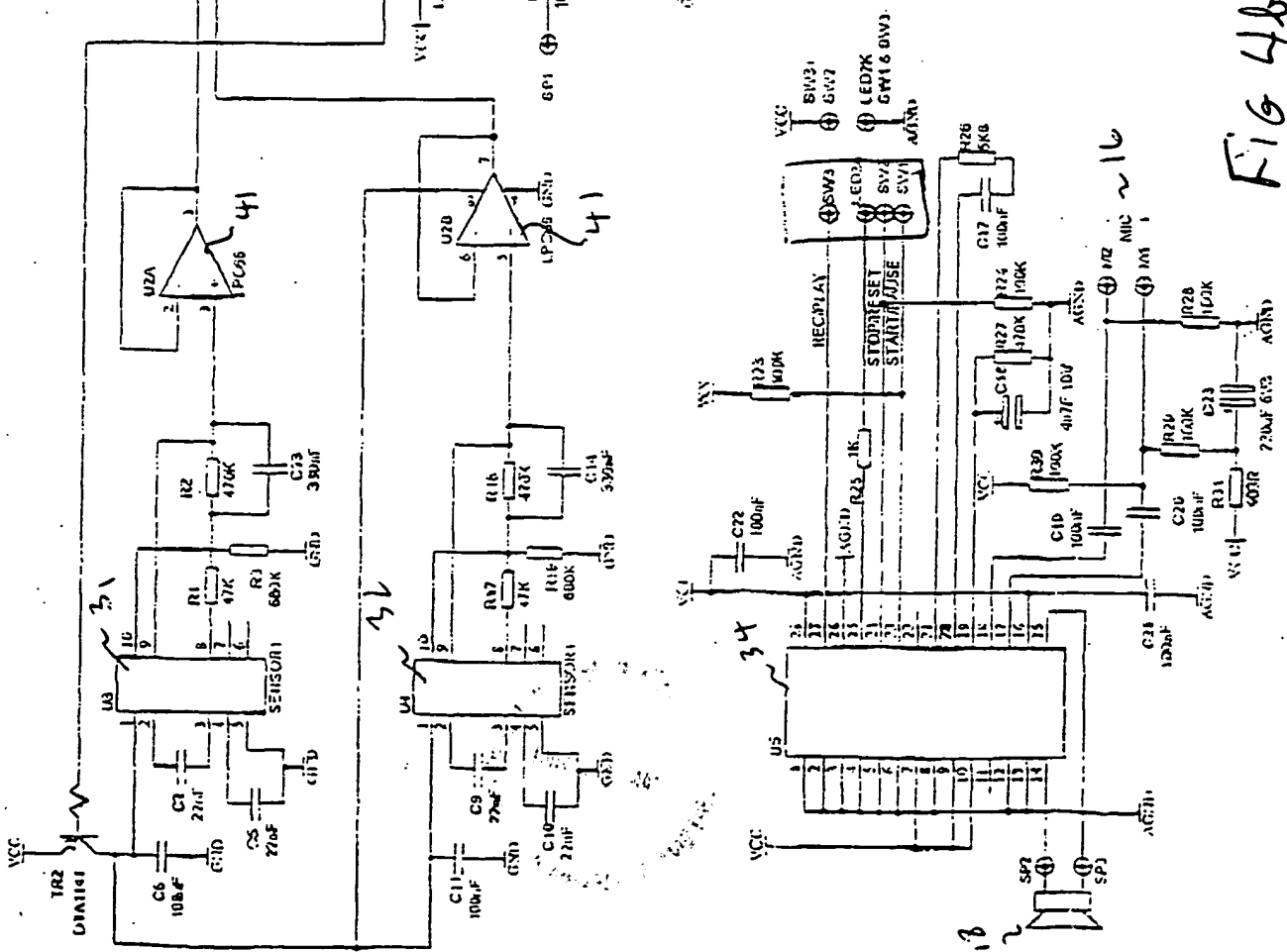


Fig 4b



FOR SN 09/171,921

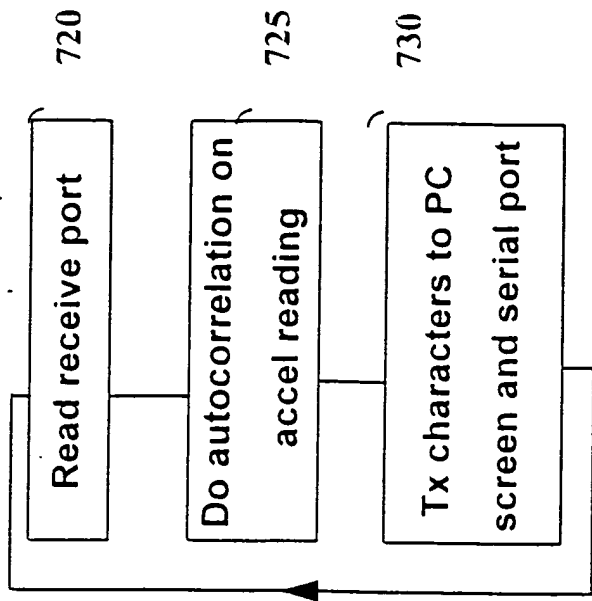


Fig 7a

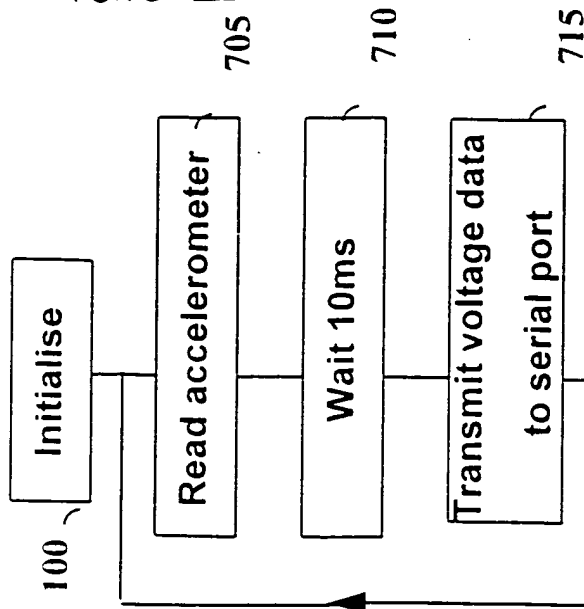


Fig 7a-b

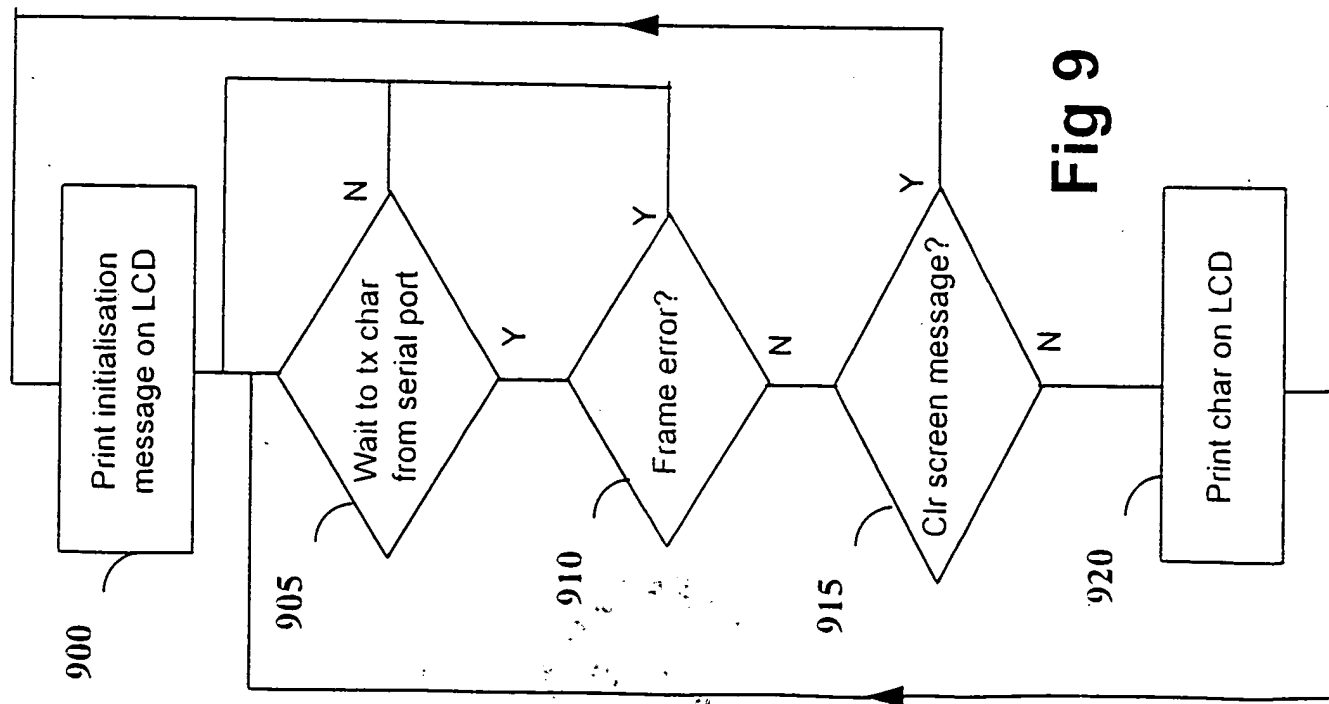


Fig 9

PROPOSED DRAWING AMENDMENTS
FOR SN 09/171,921

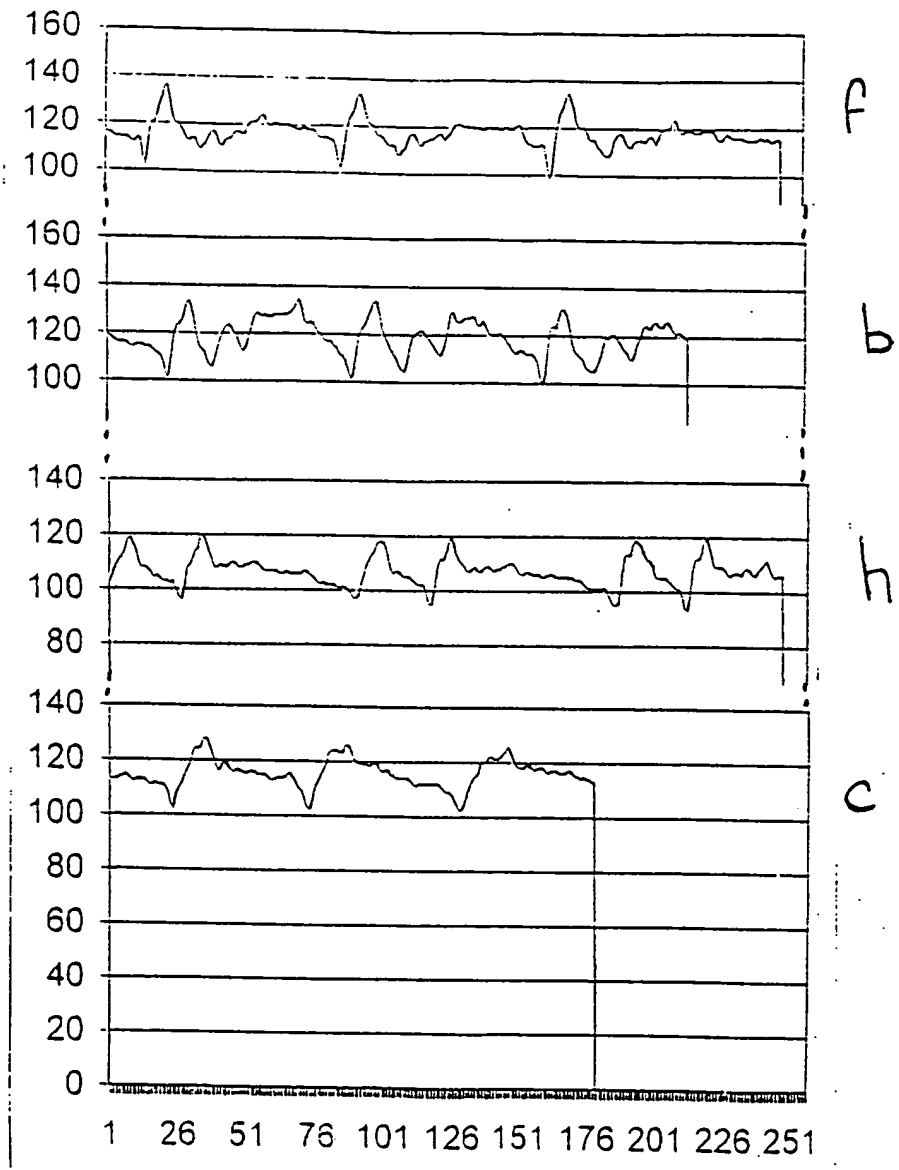


FIG 14

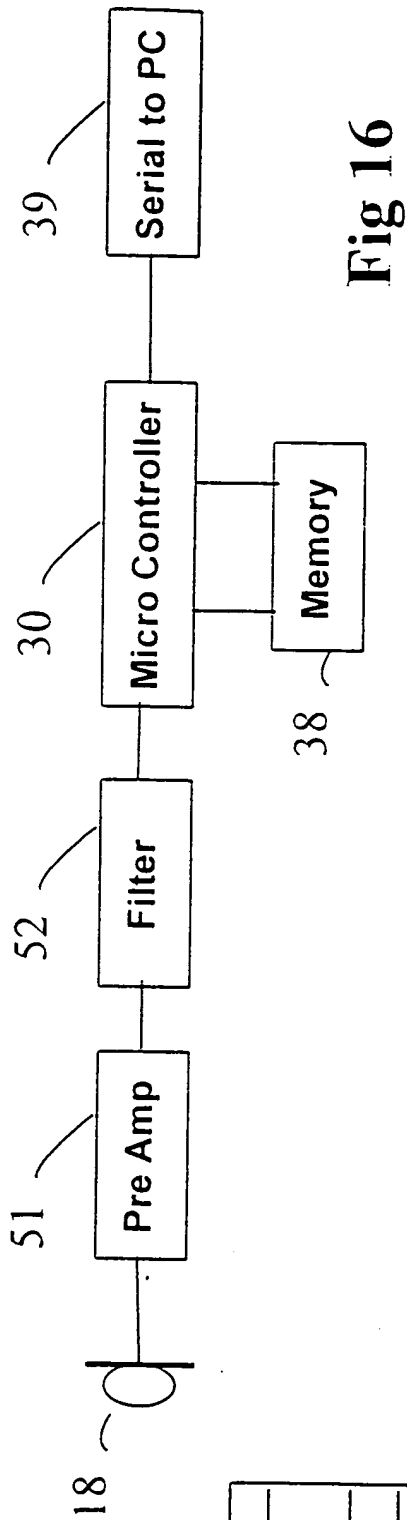


Fig 16

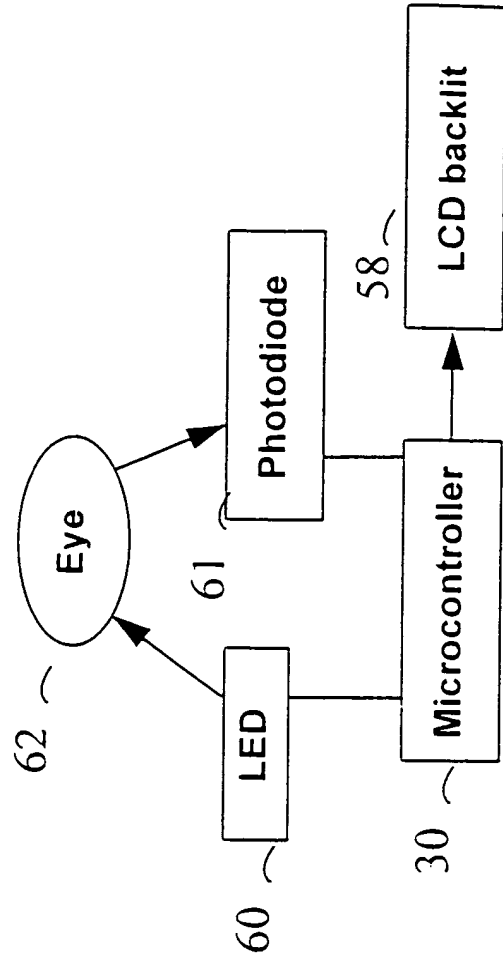


Fig 15

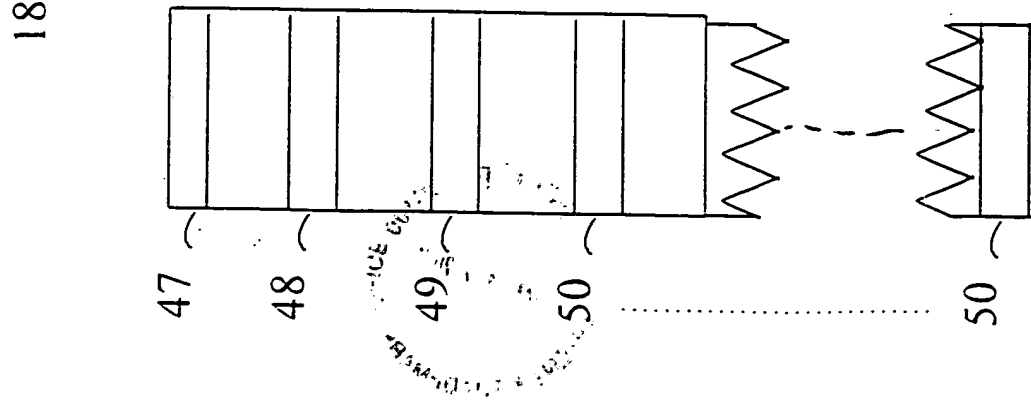


Fig 19